

REMARKS

This Amendment is being provided in response to the Office Action mailed September 13, 2001.

Applicant will number the paragraphs below to correspond to the Office Action of September 13, 2001, for the convenience of the Examiner.

2, 3. The Examiner raised a non-statutory double patenting rejection as related to Application Serial No. 09/590,585. Applicant is enclosing herein a Terminal Disclaimer as related to Application Serial No. 09/590,585 to the extent that double patenting of subject matter may exist pursuant to the judicially created doctrine of non-statutory double patenting.

4,5. The Examiner next rejected claims 48-51 and 76-78 pursuant to 35 U.S.C. §102 in view of Hall U.S. Patent No. 5,585,783.

With respect to 35 U.S.C. §102, the Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. Jamesbury Corp. v. Litton Indus. Products, 756 F.2d 1556, 225 U.S.P.Q. 253 (Fed. Cir. 1985); Atlas Power Co. v. E.I. DuPont deNemours, 750 F.2d 1569, 24 U.S.P.Q. 409 (Fed. Cir. 1984); American Hospital Supply v. Travenol Labs., 745 F.2d 1, 223 U.S.P.Q. 577 (Fed. Cir. 1984).

Applicant respectfully asserts that Applicant's amendments to the claims herein and new claims as presented for consideration are not anticipated by the Hall '783 reference, particularly with respect to the simultaneous generation of two or more visually distinct warning light signals and/or the generation of two or more visually distinct warning light signals in combination.

Applicant respectfully asserts that Applicant's claims as amended herein and new claims are allowable in view of the appropriate standard pursuant to 35 U.S.C. §102. Allowance of claims 48-52, 60-68, and new claims 80-97 herein is respectfully requested.

6,7. The Examiner next rejected claims 64-67 and 70-75, pursuant to 35 U.S.C. §103 over Hall 5,585,783; claims 52-61 and 68-69 over Schugt 5,934,694 in view of Hall '783 and in further view of Deese 5,806,965; claims 62-63 pursuant to 35 U.S.C. §103 over Hall '783 in

view of Schugt '694. The Examiner objected to claims 77 and 79 as being dependent from a rejected base claim, but indicated allowability if rewritten in independent form to include all the limitations of the base claim and any intervening claims.

With respect to 35 U.S.C. §103, the Federal Circuit has set out at least five principles regarding obviousness determinations under §103. *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986). In *Hodosh*, the Federal Circuit stated:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying §103:

- (1) the claimed invention must be considered as a whole (35 U.S.C. 103; see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984) (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art));
- (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 488 (Fed. Cir. 1984));
- (3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));
- (4) "ought to be tried" is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026); and
- (5) the presumption of validity remains constant and intact throughout litigation (35 U.S.C. 285; e.g., *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359-60, 220 USPQ 763, 770 (Fed. Cir. 1984)).

Furthermore, when an attempt is made to combine two references A and B, or to change a single reference, a prima facie case of obviousness has not been established if:

- (1) A and B could not or would not be physically combined in an operative fashion to produce the desired result by a person of ordinary skill without use of the patentee's teachings. *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972); *In re Regel*, 526 F.2d 1399, 199 USPQ 136 (CCPA 1975); *In re Jansson*, 609 F.2d 996, 203 USPQ 976 (CCPA 1979).

(2) The intended purpose or function of either A or B, or both, is destroyed by their combination. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

(3) No suggestion why or reasons or motivation for combining A and B appears explicitly or implicitly in either A or B, or both in combination. *In re Clinton*, 527 F.2d 1226, 188 USPQ 265 (CCPA 1976). Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent a teaching or suggestion supporting the combination. *In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989); see also *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989).

(4) A and B are from such diverse arts (i.e., either or both are nonanalogous art to the claimed invention) that a person of ordinary skill in the claimed art would not look to those arts to solve the problem treated by the claimed invention. *In re Pagliaro*, 657 F.2d 1219, 210 USPQ 888 (CCPA 1981); *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979); *In re Horn*, 203 USPQ 969 (CCPA 1979).

(5) A and B do not teach the source of the problem and the recognition of the source of the problem is what is unobvious. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923); *In re Spinnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969); *In re Peehs*, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980). See *Kayton*, 1 Patent Practice 5-28, 29 (1985).

In addition, in the recent case of *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC 1999), the Court of Appeals for the Federal Circuit has stated that the ultimate determination of whether an invention is or is not obvious is a legal conclusion based upon underlying factual inquiries including:

- (1) The scope and content of the prior art;
- (2) The level of ordinary skill in the prior art;
- (3) The differences between the claimed invention and the prior art; and
- (4) Objective evidence of non-obviousness.

The Court of Appeals for the Federal Circuit went on to state that the analysis with respect to obviousness is required to be conducted “at the time the invention was made” to guard against entry into the “tempting but forbidden zone of hindsight”. The Court of Appeals

for the Federal Circuit went on to state that the “very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”. The Court of Appeals for the Federal Circuit has stated that the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references and that one of ordinary skill in the art would have been motivated to select the references and combine them, and it was error to not elucidate any factual teachings, suggestions, or incentives from the prior art that showed the propriety of combination. The Federal Circuit in *Dembizcak* further stated that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability which is the essence of hindsight.

The Deese ‘965 reference teaches a stationary beacon having LED’s for the provision of a rotating light. The Deese ‘965 patent further discloses use in traffic signals. The Deese ‘965 reference further discloses colored LED’s to produce a desired color such as white where the cylindrical circuit board provides omnidirectional light.

No suggestion, motivation, or teaching is provided in the Deese ‘965 reference for use of a controller to simultaneously generate two or more light signals. No suggestion, motivation, or teaching is provided in the Deese ‘965 reference for combination with any other reference to provide a controller utilized to simultaneously generate two or more light signals. No suggestion, motivation, or teaching is provided in the Deese ‘965 reference for use of a controller to generate two or more light signals in combination. No suggestion, motivation, or teaching is provided in the Deese ‘965 reference for combination with any other reference to provide a controller for generation of two or more light signals in combination.

The Hall ‘783 reference teaches the use of a marker light having LED’s for use on an Amish buggy. The Hall ‘783 reference teaches the use of a flexible circuit board and the turning of a group of LED’s on and off at a desired interval to provide a flashing light. The Hall ‘783 reference further teaches an alternative for an electronic sequencer circuit. The Hall ‘783


reference also mentions colored LED's.

No suggestion, motivation, or teaching is provided in the Hall '783 reference for use of a controller to simultaneously generate two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Hall '783 reference for combination with any other reference to provide a controller for simultaneous generation of two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Hall '783 reference for generation of two or more visually distinct warning light signals in combination. No suggestion, motivation, or teaching is provided in the Hall '783 reference for combination with any other reference to provide a controller utilized to generate two or more visually distinct warning light signals in combination.

The Schugt U.S. Patent No. 5,934,694 teaches the use of a vehicle for retrieval of shopping carts which includes the safety feature of a rotating beacon.

No suggestion, motivation, or teaching is provided in the Schugt '694 reference for use of a controller to simultaneously generate two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Schugt '694 reference for combination with any other reference to provide a controller utilized to simultaneously generate two or more visually distinct warning light signals. No suggestion, motivation, or teaching is provided in the Schugt '694 reference for use of a controller for generation of two or more visually distinct warning light signals in combination. No suggestion, motivation, or teaching is provided in the Schugt '694 reference for combination with any other reference to provide a controller utilized to generate two or more visually distinct warning light signals in combination.

For the above-identified reasons, Applicant respectfully asserts that no motivation or suggestion is provided in either the Deese '965, Hall '783, and/or Schugt '694 references for combination to teach Applicant's claims herein. Further, Applicant asserts that the Deese '965, Hall '783, and/or Schugt '694 references may not be combined in an operative fashion to yield Applicant's invention herein. Further, for the above-identified reasons Applicant respectfully requests withdrawal of the 35 U.S.C. §103 rejection of Applicant's claims as amended herein. Applicant respectfully requests reconsideration and allowance of Applicant's claims 48-52, 60-

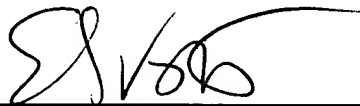


68, and new claims 80-97 herein. Issuance of an early Notice of Allowance is earnestly solicited. Should the Examiner have any questions concerning this Amendment and remarks, the Examiner is cordially invited to contact the undersigned via E-mail, facsimile, and/or by telephone at the below-identified addresses.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: December 13th, 2001

By: 
Edwin E. Voigt II, Esq.
Registration No. 36,042

Suite 2000
6109 Blue Circle Drive
Minnetonka, MN 55343-9131
Telephone No.: (952) 563-3000
Facsimile No.: (952) 563-3001
E-Mail: evoigt@vaslaw.com
F:\WPWORK\EEV\9184-AMD.C13

21

Marked-Up Version to Show Changes Made

48. (Amended) A multiple warning signal light for use with a motorized vehicle, the multiple warning signal light comprising:

- a) a light support having a front side with a first visible exterior surface;
- b) a plurality of light emitting diodes arranged about and attached to the first visible exterior surface; and
- c) a controller in electric communication with the light emitting diodes, the controller constructed and arranged to activate the light emitting diodes thereby producing more than two different types of visually distinct warning light signals, the controller further constructed and arranged to produce the more than two different types of visually distinct warning light signals simultaneously, said light emitting diodes receiving power from a power source.

50. (Amended) The multiple warning signal light of claim [48] 49, wherein the controller controls the light emitting diodes on the first visible exterior surface and second visible exterior surface for the provision of different warning light signals on the first visible exterior surface and second visible exterior surface.

51. (Amended) The multiple warning signal light of claim [50] 48, the controller having a microprocessor.

52. (Amended) The multiple warning signal light of claim [51] 48, said plurality of light emitting diodes comprising light emitting diodes of at least two different colors.

60. (Amended) The multiple warning signal light of claim [56] 48, wherein the warning light signal is a directional indicator.

61. (Amended) The multiple warning signal light of claim [53] 48, further comprising a programmable external controller for programming said controller.

62. (Amended) The multiple warning signal light of claim [53] 48, wherein the motorized vehicle is a utility vehicle.

63. (Amended) The multiple warning signal light of claim [53] 48, wherein the motorized vehicle is an emergency vehicle.

20

64. (Amended) A multiple warning signal light for use with a motorized vehicle, the multiple warning signal light comprising:

- a) a light support having a front side with a first visible exterior surface[, the front side characterized as being planar];
- b) a plurality of light emitting diodes arranged about and attached to the first visible exterior surface; and
- c) a controller in electric communication with the light emitting diodes, the controller constructed and arranged to activate the light emitting diodes thereby producing more than two different types of visually distinct warning light signals, the controller further constructed and arranged to produce the different types of visually distinct warning light signals in one combination, said light emitting diodes receiving power from a power source.

65. (Amended) The multiple warning signal light of claim 64, said light support further comprising a back side [characterized as being planar], said back side having a second visible exterior surface having a plurality of light emitting diodes arranged about and attached to the second visible exterior surface.

67. (Amended) The multiple warning signal light of claim [66] 64, the controller having a microprocessor.

68. (Amended) The multiple warning signal light of claim [67] 64, said plurality of light emitting diodes comprising light emitting diodes of at least two different colors.